

Atty Docket No.: 10416/15  
Serial No. 10/039,490

REMARKS

Claim Rejections - 35 U.S.C. §103(a) – Claims 1-3, 5, 6, 8-12, and 16-20

Claims 1-3, 5, 6, 8-12, and 16-20 are pending in the present application and were rejected in the Office action dated October 6, 2003 under 35 U.S.C. § 103(a) as being unpatentable over Scifres et al. (U.S. Patent No. 4,280,107) in view of Uno et al. (U.S. Patent No. 6,240,235). Applicant respectfully traverses this rejection. Claims 1, 8, 10, 12, and 16 have been amended. Claims 2, 9, and 17 have been deleted. No new claims have been added. Claims 1, 8, and 16 are independent claims. Claims 3, 5, and 6 depend, either directly or ultimately, from independent claim 1. Claims 10-12 depend, either directly or ultimately, from independent claim 8. Claims 18-20 depend, either directly or ultimately, from independent claim 16. For brevity, only the bases for the rejection of the independent claims are traversed in detail in this response, on the understanding that the dependent claims are also patentably distinct over the prior art as they depend directly from their respective independent claim. Nevertheless, the dependent claims include additional features that, in combination with those of their respective independent claim, provide further, separate and independent bases for patentability.

A significant advantage of the invention recited in the independent claims over the prior art is that the claimed semiconductor laser, which utilizes a laser beam-emitting facet, includes “a three dimensional marker indicating the location of the light-emitting region, wherein the three dimensional marker is located in the indicator region, and wherein the three-dimensional marker is at least one of a concavity and a convexity formed on the laser beam-emitting facet in the indicator region.”

The Examiner readily admits that the “reflector structure” taught in the Scifres reference does NOT disclose anything that corresponds to the concavity element recited in the independent claims. Instead, the Examiner cites the Uno reference as disclosing such a feature. Importantly, however, the Uno reference relates to “optical fiber fixing members,” and as such is completely unrelated and non-analogous art with respect to the claimed invention. Indeed, an examination of the Technical Field and Background Art sections of the Uno reference are directed to optical fiber production for use in optical communications applications. Further, even the U.S. classes and Field of Search cited on the Uno patent appear to be unrelated to those cited on the Scifres

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patent. As such, Applicant respectfully submits that this combination of references had been made using improper hindsight, and that there is no proper basis or motivation combining the Scifres reference with the non-analogous Uno reference, or for expecting one of ordinary skill in the art to make such a combination.

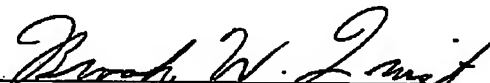
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CONCLUSION

Applicants have made an earnest and bona fide effort to clarify the issues before the Examiner and to place this case in condition for allowance. In view of the foregoing discussions, it is believed clear that the differences between the claimed invention and the prior art are such that the claimed invention is patentably distinct over the prior art. Therefore, consideration and allowance of claims 1, 3, 5, 6, 8, 10-12, and 18-20 is believed to be in order, and an early Notice of Allowance to this effect is respectfully requested. If the Examiner should have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (310) 712-8319. The undersigned attorney can normally be reached Monday through Friday from about 9:30 AM to 6:30 PM Pacific Time.

Respectfully submitted,

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